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10/619,656	07/15/2003	Klaus Hilbig	CM2504RQ	7175
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

DEC 12 2006

GROUP 1700

Application Number: 10/619,656

Filing Date: July 15, 2003

Appellant(s): HILBIG ET AL.

Peter D. Meyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 28, 2006 appealing from the Office action mailed June 23, 2006(1)

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Applicants arguments with respect to the 103(a) rejection over Chen et al., US Patent No. 5,990,377 in view of applicants

admission and further evidenced by Müller, GB 2376436 A, or Roussel et al., WO 99/45205 or Hein et al., US Patent No. 6,863,107 B2 or Kamps et al., US Patent No. 5,702,571, is convincing and it has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,352,700 LUU et al. 03-2002

5,702,571 KAMPS et al. 12-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luu et al., US Patent No. 6,352,700 in view of applicants admission of prior art or Kamps et al.

Luu et al. teach a tissue, which is lotioned to increase the softness of the tissue, increase soothing, lubricious feel, abstract. They teach that the tissue has the effect of keeping the skin mantle while making the product feel smooth, lubricious and non-greasy, see abstract, which indicates that the lotion is transferable, i.e., the lotion is transferred to the skin. They teach also that the tissue could be embossed, column 3, lines 32-38. Luu et al., teach the embossing of lotioned tissues, but are silent with respect to the type of embossing. However, Kamps et al. teach a tissue which is embossed with embossed rolls, which could be steel or rubber rolls or a combination of steel and rubber rolls, column 3, lines 29-38, said rolls having at least 15 discrete, male elements per square centimeter, preferably from about 30 to 95 embossing elements/cm², column 3, lines 49-65 and that embossing in such a way produces a tissue having adequate softness, bulk and strength and having an unique balance of properties, see abstract. Therefore, embossing the tissues taught by Luu et al. using the embossing rolls taught by Kamps et

al. would have been obvious to one of ordinary skill in the art in order to obtain the advantages discussed above. Moreover, applicants admit that stretch embossing is a well-known embossing process and therefore, functional equivalent to conventional embossing processes. One of skill in the art would have reasonable expectation of success if the embossing of the secondary references were used to emboss the tissue(s) of the primary reference, see previous action. Moreover, it has been held that “[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.” In re Fout 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 152 USPQ 618 (CCPA 1967) and both primary references suggest the embossing of the tissue(s).

Even though neither Luu et al. nor Kamps et al. teach the dynamic and static transfer properties, these properties *Must* be the same, i.e., inherent to the combination of the references, because the tissue of the combination is the same as the one claimed, i.e., a lotioned tissue, which lotion is transferable to the skin and with same embossing pattern. Note that the relationship of the transfer would be also within levels of the combination, for the same reason(s) stated above. Note that, applicants examples demonstrate that the same claimed ratio of lotion is transferred irrespectively if the tissue is embossed or not, i.e., the data shown on page 9 of the present application, clearly teach that the dynamic transfer is more than double of the static transfer, 21.83% vs. 5.14%, this seems to indicate that this is a trend for all tissues having transferable lotions.

(10) Response to Argument

Applicants arguments with respect to the 103(a) rejection over Chen et al. is convincing and it has been withdrawn.

Applicant's arguments filed on September 28, 2006 with regard to the 103(a) rejection in view of Luu et al. have been fully considered but they are not persuasive.

Applicants argue that the examiner has used applicants' disclosure to provide the necessary rationale for an obviousness rejection. The examiner respectfully disagrees, because the motivation to combine has been taken from the references and from common knowledge, i.e., the admission of prior art. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants also argue that the combination of reference does not teach nor suggest the required transference capability. The examiner contention is not that the combination of references explicitly teaches the transference capability, but this property is inherent to the combination of references, because the combination of the references would make the same tissue as claimed, i.e. a tissue with a transferable lotion which is embossed by stretch embossing. There are no arguments by applicants that the tissue of the cited reference would not produce the claimed tissue and there is nothing on the record that either precludes the combination of the patents, or a showing of unexpected results and

therefore, the combination of the patents is proper and as stated above, such combination would produce a tissue with the same properties as those of the claimed invention. Also there is nothing in the claims that indicates that the transference capability is due a determined procedure, process steps, other than the particular embossing process to a lotioned tissue and since the tissue of the combination of the references has all the claimed process limitations then such combination reads on the claims as claimed.

Note that it has been held that “[T]he arguments of counsel cannot take the place of evidence in the record.” In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience [from the Attys. point of view] is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

José A. Fortuna

Conferees:





**Jennifer Michener
QAS - Appeals
TC 1700**

Jennifer Michener



Christopher Fiorilla